

R E M A R K S**A. INTRODUCTION**

Claims 1-31, 35, 36, 41, 42, 49-56, 60-65, 72-77 and 80-101 are pending and rejected.

Upon entry of this Amendment:

- Claims 1 and 81-101 will be pending
- Claims 1, 81, and 82 will be amended
- Claims 2-80 will be cancelled without prejudice
- Claims 1, 81, and 82 will be the only independent claims

B. SECTION 112 ¶ 2 REJECTION: INDEFINITENESS

Claims 21-25 and 31 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which we regard as the invention. We respectfully traverse the Examiner's Section 112 ¶ 2 rejection of Claims 21-25 and 31.

Claims 21-25 and 31 are now cancelled, but the rejection is addressed in order to clarify particular subject matter. As previously recited, the terms of the recited offer in Claim 1 did not require commitment to a service agreement for any item being purchased. In other words, contrary to the Examiner's statement in the Office Action, Claim 1 did not recite a complete absence of service agreements—only service agreements tied to the item(s) being purchased.

Claims 22-25 (now cancelled) explicitly provided for various embodiments referring to service and/or switching service. However, Applicants submit that there is, as explained above, nothing unclear, much less contradictory, with having a user switch services. It is clear from Claim 1 that the offer does not require a service agreement for an item being purchased—nothing in that limitation precludes the offer from requiring the customer to switch services. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the Section 112 rejections of Claims 22-25.

Claim 1 has now been amended in order to specify that the offer is for the customer to commit to a service agreement but not a service agreement for any item being purchased. For example, if the customer is purchasing a cellular telephone, the offer for the subsidy does not require the customer to commit to a cellular telephone service agreement for the cellular telephone being purchased. Claim 1, however, does encompass an embodiment in which the customer is

purchasing a cellular telephone (or book, or mp3 player) and the offer requires the customer to commit to an insurance service unrelated to the cellular telephone.

Applicants respectfully note that neither Claim 21 nor 31 (now cancelled) refers explicitly to a service, and therefore the stated rationale for rejection is not appropriate.

C. SECTION 103(A) REJECTIONS

Claims 1, 3-4, 8-21, 26, 28-30, 35, 36, 41, 42, 49-56, 60-65, 72-77 and 80-101 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (U.S. Patent No. 6,055,513), and further in view of Brian Donlon (“Cable industry channels its efforts in April; sampler of specials”) USA Today and Anonymous (“Manufacturers shine with cross-promotional prowess”) Discount Store News. We respectfully traverse the Examiner’s Section 103(a) rejection.

Claim 2 stands rejected as being unpatentable over Katz in view of Donlon or Discount Store News.

Claims 5-7 stand rejected as being unpatentable over Katz in view of Donlon or Discount Store News and further in view of Kanter (U.S. Patent No. 5,537,314).

Claims 22-25 stand rejected as being unpatentable over Katz in view of Donlon or Discount Store News and further in view of the articles “Selling a free phone” by Dana Spoor, Cellular Business and “Credit Card firms drive down costs” by Stephen Ellis, Times Newspapers Limited.

Claims 27 and 31 stand rejected as being unpatentable over Katz in view of Donlon or Discount Store News.

We respectfully traverse the Section 103(a) rejections.

Claims 2-80 are cancelled without prejudice.

1. Independent Claims 1, 81, and 82

Each of independent claims 1, 81, and 82 has been amended and now provides generally for a feature *wherein the offer for the subsidy from the second vendor requires commitment to a service agreement but does not require the customer to commit to a service agreement for an item being purchased [or placed in a shopping cart]*.

The above recited feature generally provides for an offer for a subsidy from a second vendor for a purchase at a first vendor, in which the offer requires a service agreement but does not depend on the customer committing to a service agreement for anything the customer is purchasing from the first vendor. None of the cited references, alone or in combination, teaches or suggests such a feature.

Contrary to the Examiner's assertion, Katz does not teach or suggest an offer from a second vendor. None of the cited portions of Katz supports the Examiner's assertion. Further, nothing in either Discount Store News or Donlon suggests a commitment to a service agreement offered by a second vendor. In Discount Store News, for example, the "cross-selling" is with respect only to prepackaged combinations of store-shelf products to be purchased only from one vendor. In Donlon, there is no requirement of a service agreement, nor is there any hint of applying the "coupon" to the cable bill with which it is provided.

For at least these reasons, Applicants respectfully request the Examiner's reconsideration and allowance of independent Claims 1, 81, and 82 (and dependent Claims 83-101).

D. ADDITIONAL COMMENTS

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner's interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

E. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES

We understand that a three-month extension of time to respond to the Office Action is necessary.

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Charge: \$1050.00

Deposit Account: 50-0271

Order No.: 99-007

Please credit any overpayment to the same account.

F. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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Date

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